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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,253

12/01/2003

Takaaki Chosokabe

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11/02/2006

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EXAMINER

VIJAYAKUMAR, KALLAMBELLA M

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/724,253

Applicant(s)

CHOSOKABE ET AL.

Examiner

Kallambella Vijayakumar

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1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-8 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application
 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-8 are currently pending with the application. Claims 1-2 and 4 were amended for clarity. Claim-8 was newly added.

The examiner has fully considered the arguments filed 08/07/2006, and not persuasive to overcome the prior art by Tuller and Ogata et al cited in the last office action for the following reasons:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuller et al (US 5,403,461).

The use of phrase "for thermistor devices" in the claim-1 has not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to

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the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Tuller et al teach a sintered compact bar of a solid electrode/electrolyte containing solid solutions of the type ABO_3 such as $(La_{1-j}Sr_j)(Al_{1-k}Mn_k)O_3$, wherein the A-cations include rare-earths such as Y, Nd, Sm; $0 \leq j < 1$; $0 \leq k \leq 1$ (Col-11, Ln 41-44; Col-7, Ln 19-20; Col-5, Ln 25-29, 38-43). The structure meets the limitation of a device in claim-8. All the limitations of the instant claims are met.

The reference is anticipatory.

2. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogata et al (US 6,878,304).

Ogata et al teach a temperature sensor containing a thermistor formed from a mixed sintered body with the composition $(M1M2)O_3.AO_x$, wherein M1 is at least one element selected from Ca, Sr, Y, Sm, Yb; M2 is at least one element selected from Al, Mn and AO_x is silica (Abstract, Col-2, Ln 38-66, Col-3, Ln 10-12; Fig-2A). All the limitations of the instant claims are met.

The reference is anticipatory.

Response to Arguments

Applicant's arguments filed 08/07/2006 have been fully considered but they are not persuasive. Applicants argue that the instant claims exclude La that is correct (Response, Pg-6, Ln 3-4). Applicants argue that although the solid solution composition by Tuller et al broadly overlaps with applicants claims, it does not have needed specificity (Res, Pg-7, Ln 9-15). Applicants further argue that the perovskite composition by Tuller et al essentially contains La (Pg-7, Ln 1-4). Applicant's arguments are not persuasive because the prior art disclosure containing a mixed-metal-perovskite having La is merely an exemplary example of mixed-metal-perovskite species chosen from the genus of solid solutions, and the perovskite compositions are not limited to La-containing perovskites only as argued (Col-7, Ln 19-20). The prior art clearly teaches compositions containing rare-earth elements other than La in the A-site of

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the solid solutions/perovskites that clearly overlaps with the instant claimed compositions. With regard to the arguments that the prior art does recognize the criticality in controlling the content "a" mole of at least one element selected from group-II, and the significance of Mn range in the composition, the prior art composition ranges clearly overlap with the instant claimed composition and any associated benefits would be inherent (Res, Pg-8, Ln 6-7, Ln 11-14). With regard to the argument that the prior art by Ogata et al does not specifically limit the thermistor composition to a specific transition metal, and the preferred mixed sintered body does not contain a Gp-II element and Al, A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

For the reasons set forth above, the instant claims fail to patentably distinguish over the prior art teachings. Applicants are invited contact the examiner to discuss the patentability issues.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 8.30-6.00 Mon-Thu, 8.30-5.00 Alt Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KMV
October 27, 2006.



DOUGLAS MCGINTY
SUPERVISORY PATENT EXAMINER

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